

REMARKS

In view of the above amendments and the following remarks, reconsideration of the rejections set forth in the Office Action of December 19, 2004 is respectfully requested.

As an initial matter, the Examiner is requested to note that all of the claim amendments indicated above (which will be explained in more detail below) are directed merely to matters of form; or were made to combine the subject matter of a first claim and a second claim depending directly from the first claim. Therefore, it is submitted that these claim amendments raise no new issues, and the Examiner is thus respectfully requested to enter and consider the amendments at this time notwithstanding the finality of the outstanding Office Action.

The Examiner rejected claims 15-17, 20, and 21 under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner rejected the claims as including new matter, although the Examiner also appeared to acknowledge that the originally-filed specification teaches the recited subject matter. Specifically, the Examiner noted that paragraph [0016] relates to SiC particles in the volumetric percentages claimed in dependent claim 15, “but only in the context of other unclaimed limitations.” Similarly, the Examiner acknowledged that paragraph [0016] also related to the subject matter recited in dependent claim 16, “but only in the context of other unclaimed limitations.”

The Examiner’s statement “only in the context of other unclaimed limitations” is not entirely clear. In this regard, it is well-known that it is not necessary to claim *every* feature (limitation) disclosed in the specification with respect to a particular embodiment. Furthermore, as acknowledged by the Examiner, paragraph [0016] of the specification discloses a particular embodiment of the invention recited in independent claim 9, and clearly provides support for the subject matter recited in claims 15 and 16. Thus, contrary to the Examiner’s assertion, it is submitted that one of ordinary skill in the art would fully understand that the Applicants had possession of the claimed invention at the time the application was filed. Nonetheless, the Examiner is requested to note that dependent claim 15 has now been amended to incorporate the subject matter of dependent claim 16 (which originally depended directly from claim 15) in an attempt to further the prosecution of this application. In addition, claims 16, 17, 20, and 21 have been cancelled. In

view of the above, it is respectfully submitted that the Examiner's rejections under § 112, first paragraph, have been overcome.

The Examiner rejected claims 9-21 under 35 USC § 112, second paragraph, as being indefinite. In particular, the Examiner specifically cited two examples of language used in the claims that renders the claims indefinite, and each of these examples will be discussed separately below.

Firstly, the Examiner indicated that it is unclear what is meant by the phrases "providing at least one of a brake disc and a clutch plate" and "a friction member on each of the at least one of a brake disc and a clutch plate" as recited in independent claims 9 and 18. As discussed with the Examiner during a telephone conversation on December 30, 2003, the phrase "providing at least one of a brake disc and a clutch plate" means "providing a brake disc, a clutch plate, or a brake disc *and* a clutch plate." Thus, the phrase "each of the at least one of a brake disc and a clutch plate" means "each of the brake disc, the clutch plate, or the brake disc *and* the clutch plate," depending on which of these elements are present. As explained to the Examiner, the original language was used in an effort to avoid using the term "or" which is often objected to by Examiners as being informal alternative language. However, in view of the Examiner's expressed preference for the phrase "either a brake disc, a clutch plate, or a disc brake and a clutch plate," independent claim 9 and dependent claim 15 have now been amended to replace the original phrase with the phrase preferred by the Examiner, and independent claim 18 has been cancelled. However, it is noted that the amendments to claims 9 and 15 are not intended to change the scope of the claims.

The Examiner also indicated that it is unclear whether the claimed particle size dimensions as recited in claims 16 and 21 are correct. In particular, the Examiner noted that Figures 3 and 4 appear to depict particles that are considerably smaller than 5μ , although paragraph [0016] refers to particles of the claimed size. In an attempt to address this matter, the subject matter of claim 16 has now been amended to recite that "the reinforcing particles *include* particles having a size in a range of 5μ to 30μ ," so that the language now accounts for the particles depicted in Figures 3 and 4 that are considerably smaller than 5μ . In this regard, however, the subject matter of claim 16 has now been incorporated into dependent claim 15 as explained above.

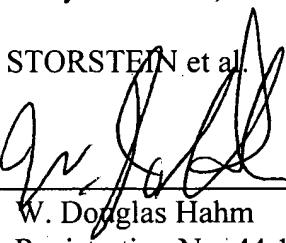
With respect to the Examiner's rejections of claims 9-21 under § 112, second paragraph, the Examiner is also requested to note that claims 17-21 have now been cancelled. Thus, in view of the above amendments and remarks, it is respectfully submitted that the Examiner's rejections of claims 9-21 under § 112, second paragraph, have been overcome.

The Examiner has rejected claims 9, 18, and 19 under 35 USC § 102(b) as being anticipated by the Ross reference (USP 5,765,667); and has rejected claims 9 and 18 under 35 USC § 103(a) as being unpatentable over the Burkhard reference (USP 4,180,622). However, the Examiner did not provide any prior art rejections of dependent claims 10-14 which depend from claim 9. Thus, independent claim 9 has now been amended to incorporate the subject matter of dependent claim 10, and claim 10 has been cancelled. In addition, dependent claim 14 has now been amended so as to be placed in independent form including the subject matter of independent claim 9 (amended in order to address the formal matters discussed above), and dependent claims 11-13 have been amended so that they now depend directly from independent claim 9, rather than cancelled claim 10. Finally, as indicated above, independent claim 18 and the claims that depend therefrom have also been cancelled. Accordingly, it is respectfully submitted that amended independent claims 9 and 14, and the claims that depend therefrom, are now in condition for allowance.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

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